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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,351

10/21/2003

Seth A. Foerster

OP-11-1

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EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3734

NOTIFICATION DATE

DELIVERY MODE

01/24/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel\_prop@arthrocare.com

## Office Action Summary

Application No.

10/690,351

Applicant(s)

FOERSTER ET AL.

Examiner

Victor X. Nguyen

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/16/2007.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The request filed on 11/16/2007 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/690,351 is acceptable and a RCE has been established. An action on the RCE follows.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification (submitted on 10/21/2003) in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In **claim 1**, the disclosure does not describe “*said second configuration characterized by said outer peripheral wall being radially enlarged at a point along said longitudinal axis such that said apparatus has a larger cross section in said second configuration than in said first configuration at said point*”. In claim 9, the disclosure does not describe “*said plurality of spaced slits comprises at least six slits disposed about the circumference of said outer peripheral wall*”. Clarification is requested.

#### Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. None of the drawings of Applicant illustrates *a reference number for a larger cross section in the second configuration as recited in claim 1*.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-12 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kearns et al (6,156,056).

Kearns et al disclose in figures 23-25 and abstract, a device for attaching connective tissue to bone, including: a body 402 has a first configuration and second configuration, where the

body includes a plurality of spaced slits 418, where each of the slits has a length, and where a distance x occurs at 418 which is smaller than a distance y occurs at 428. Kearns is silent that the second configuration can be radially enlarged such that the apparatus has a larger cross section in the second configuration than in the first configuration at the point. Instead, Kearns indicates that the device has a first configuration in fig. 24 and a second configuration in figure 25, where the arrangement of slits 418 and 428 would promote some sort of radial expansion at the longitudinal axis.

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to modify Kearns' device with the second configuration can be radially enlarged such that the apparatus has a larger cross section in the second configuration than in the first configuration at the point because Applicant has not disclosed that the second configuration can be radially enlarged such that the apparatus has a larger cross section in the second configuration than in the first configuration at the point provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Kearns' device, and applicant's invention, to perform equally well with either the device taught by Kearns because both device would perform the same function of providing a hollow tube has a plurality of slits to attach soft tissue to bone. Therefore, it would have been obvious to modify Kearns to obtain the invention as specified in the above claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Kearns. Where each of the slits can comprise an angled surface at an end thereof (see fig. 23 at element 418), where the plurality of spaced slits 418 has an acute angle which is between 0 and 45 degrees (see col. 4,

lines 20-25), and where the plurality of spaced slits comprises at least six slits (fig. 23), and where the device further comprises a suture retaining feature (100 or 400, see col. 3, lines 65-67 and col. 4, lines 1-5). As to claims 4-25, Kearns discloses in figures 1, 23-25, abstract and col. 3, lines 50-62 an apparatus for attaching tissue to bone having the limitations as described above.

#### **Allowable Subject Matter**

5. Claim 26 is allowed over the art of record.

The following is a statement of reasons for allowance: None of the prior art of record, alone or in combination, discloses or suggests where a body includes a plurality of spaced slits disposed about the outer peripheral wall, *each of the slit extends axially and defining ribs therebetween, each of the ribs comprises a fixed proximal end, an intermediate section and a fixed distal end*, and the apparatus further comprises a laterally disposed suture hole for receiving a suture.

#### **Response to Arguments**

6. Applicant's arguments filed 11/16/2007 have been fully considered but are moot in view of new ground(s) of rejections. Applicant is asked to please refer to the modified prior art rejections above where examiner addresses applicant's concerns regarding prior art rejection.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor X Nguyen  
Examiner  
Art Unit 3734



VN VP  
1/14/2007



MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER